

REMARKS

A. Status of the Application

- Claims **26, 28-30, 33-37, 39** and **41-50** are pending in the application, of which claims **26, 42**, and **48** are independent claims.
- Claims **26, 37, 39, 41, 42** and **48** have been amended. All amendments are supported by the application and claims as originally filed. No new matter has been added.

Accordingly, entry of the amendments is respectfully requested. Applicants have amended the claims to recite particular embodiments that Applicants, in their business judgment, have determined to be commercially desirable at this time. The claim amendments have not been submitted for any reasons relating to patentability.

In the Office Action dated February 2, 2009 ("Office Action"), the Examiner rejected all of claims **26, 28-30, 33-37, 39** and **41-50** under 35 U.S.C. §103(a) as being unpatentable over U.S. 6,195,647 ("Martyn") in view of U.S. Patent Publication 2002/0161690 ("McCarthy"). Applicants respectfully contend that the rejection of these claims on the grounds presented in the Office Action contain clear legal and factual deficiencies.

B. Rejections under 35 U.S.C. §112

On page 2 of the Office Action, the Examiner rejected claims **37, 39** and **41** under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner alleges that claims **37, 39** and **41** does not set forth a definitive requirement for what constitutes "exceeding a threshold."

The rejection is moot in light of Applicants' claim amendments to claims 37, 39 and 41. Specifically, Applicants have added the following limitation: "in which the threshold is a pre-determined number." No new matter has been introduced.

C. Double Patenting Rejection

On page 2 of the Office Action, the Examiner provisionally rejects claims **26, 28-30, 33-37, 39** and **41--50** on the grounds of non-statutory obvious-type double patenting as being unpatentable over claims **13-37** of co-pending Application No. 10/759,957.

Because both the present application and Application No. 10/759,957 are currently pending, and claim amendments may be made in the applications prior to issue, Applicants will withhold further action on this rejection until at least one of these applications issues.

D. Rejection under 35 U.S.C § 103(a)

1. Certain Limitations are Not Disclosed in the Cited References

In order to establish a *prima facie* case of obviousness of a claimed invention, all of the limitations of a claim must be taught or suggested by the prior art. The Examiner's failure to address all of the limitations in claim **26** results in clear error.

Independent claim **26** recites, *inter alia*,

... receiving... a selection of a quadrant from a plurality of quadrants, in which *each quadrant comprises a portion of a customizable display* and each quadrant comprises a benchmark instrument, the selected quadrant comprising a first benchmark instrument (emphasis added).

The Examiner asserts that column 11, lines 43-44 and figure 1 of Martyn discloses "receiving... a selection of a quadrant from a plurality of quadrants," as recited by claim **26**. Office Action, p. 8. But, in actuality, the cited-portions of Martyn merely disclose:

Ticker window 12000 displays every trade and quote update for all or a selected portion of all securities.

Martyn, col. 11, lines 43-44.

Nowhere does column 11, lines 43-44 disclose or suggest a “*plurality of quadrants*,” much less “*receiving... a selection of a quadrant from a plurality of quadrants*,” as recited by claim **26**. In fact, it appears that the Examiner has misunderstood this limitation of claim **26**, since his accompanying explanation for using the cited-portions of Martyn has no bearings on the actual language of the claim.

Specifically, the Examiner argues that the cited-portion of Martyn illustrates and discusses a hardware system that is “capable of displaying a selected portion of securities.” *Id.* However, selecting a “portion of securities” does not disclose or suggest, in any way, selecting “*a quadrant from a plurality of quadrants*” in which the quadrant represents “*a portion of a customizable display*,” as recited by claim **26**.

Neither does figure 1 of Martyn supply this deficiency. At best, figure 1 provides a high-level overview of the hardware system used in Martyn. The figure shows multiple workstations (#120-128) connected to a central computer (#110). However, the displays of the workstations and the display of the central computer are completely blank—there is no disclosure or suggestion, whatsoever, that these displays are customizable or divided into multiple quadrants.

For at least this reason, the Examiner fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) for claim **26**, as well as for independent claims **42** and **48** (analogous article manufacture and apparatus claims), which recited the same limitation.

2. There is No Substantial Evidence of Motivation to Modify Martyn

The Examiner also concedes that Martyn fails to teach the following limitations of claim **26**:

retrieving....a plurality of non-benchmark instruments..., in which the first benchmark instruments comprises *a first type of instrument*, and in which the one of the plurality of non-benchmark instruments comprises *a second type of instrument that is different from the first type*; and

generating and outputting the customizable display, in which *the customizable display comprises the selected quadrant and a plurality of other quadrants*, and in which the selected quadrant comprises the retrieved market data for the first benchmark instrument and the plurality of non-benchmark instruments.

Office Action, p. 9. Instead, he asserts that the abstract of McCarthy teaches these limitations. However, contrary to the Examiner's assertion, the abstract of McCarthy does not actually teach or suggest that "*the first benchmark instruments comprises a first type of instrument*" and "*the one of the plurality of non-benchmark instruments comprises a second type of instrument that is different from the first type*," as recited in claim 26.

Rather, the abstract of McCarthy merely states the following:

A system, method and medium for performing electronic fixed income trading that allows users to specify and/or control price and/or time limits associated with potential trades while preserving buyer and seller anonymity. According to at least some of the embodiments of the present invention, a pricing module receives financial information from at least one financial data provider, and transmits the data to one or more trading entities. Purchase and/or sell offers are transmitted to a trading module, and can be defined according to any of a plurality of pricing methods. Depending on the user specified parameters that comprise the offer, the system can automatically place the user into the market, or automatically take the user out of the market. Once a trade is executed, a clearing module monitors and records the transactions executed in clearing the trade.

McCarthy, abstract.

Nowhere in the abstract of McCarthy is there a disclosure or suggestion of the first benchmark instrument being a different type than the non-benchmark instrument. For at least this reason, the Examiner fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) for claim **26**, as well as for independent claims **42** and **48**, which recite the same limitation.

Assuming *arguendo* that McCarthy discloses the above-cited limitations, the Examiner fails to provide any evidence supporting his assertion that a person of skill in the art would have been motivated to modify Martyn with McCarthy. Specifically, the Examiner argues:

Both Martyn et al. and McCarthy et al. disclose customized trading displays for financial instruments... Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martyn et. al. to include a computer capable of retrieving non-benchmark securities related to specific trading criteria (i.e., benchmark security) whereby the benchmark security and non-benchmark security are different financial instruments, and displaying the market data in grids as taught by McCarthy et. al. *in order to allow a trader to use various trading interfaces to create orders, manipulate orders, cancel orders, cycle through multiple issues, obtain trading information more relevant than limit price stacks, or efficiently buy or sell items inside or within a spread market.*

Id. (emphasis added). In other words, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Martyn for the sole reason that such combination would achieve various benefits, including the ability to create and cancel orders.

The Examiner appears to suggest that one of ordinary skill in the art would wish to selectively modify Martyn with the features of McCarthy solely because both prior art references disclose “customized trading displays for financial instruments.” However, the Examiner fails to cite any evidence for why one of ordinary skill in the art would wish to

selectively modify Martyn to include “a computer capable of retrieving non-benchmark securities related to specific trading criteria.” *Id.* at p. 10.

Moreover, there is no evidence in the record for why one of ordinary skill in the art would have, at the time of the invention, known or desired to “allow a trader to use various trading interfaces” to perform various tasks on an order and to “obtain trading information more relevant than limit price stacks”. *Id.*

Furthermore, even if a person of ordinary skill in the art did have the desire to “allow a trader to use various trading interfaces” to perform various tasks on an order and to “obtain trading information more relevant than limit price stacks,” there is still no evidence that such a person would have sought to accomplish this goal by including “a computer capable of retrieving non-benchmark securities related to specific trading criteria,” as alleged by the Examiner. *Id.* There is no reasoning provided why the latter would follow from the former, and the two would only appear disconnected and unrelated to the person of ordinary skill.

Since there has been no evidence offered, and no reasoning based on evidence, for a motivation to combine or modify the references in the manner the Examiner has proposed, Applicants cannot address the reasoning behind the obviousness rejection, and a *prima facie* showing of obviousness has not been made.

3. There is No Rational and Articulated Reason to Combine References

Furthermore, the rejection of claims **26**, **42**, and **48** is improper because the Examiner’s unsupported assertion fails to provide a rational and articulated reason for combining the teachings of Martyn and McCarthy. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, -- U.S. --, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must explicitly articulate the reasoning for combining teachings from different references. The Federal Circuit stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *To facilitate review, this analysis should be made explicit.*

KSR Int'l Co., 127 S.Ct. at 1740-41 (emphasis added). Vague and conclusory statements are insufficient to establish a reason for combining the teachings of different references. *See Innogenetics*, 512 F.3d at 1373-74 (excluding obviousness testimony that was “vague and conclusory” regarding the motivation to combine references). Here, the Examiner’s single, conclusory assertion that various benefits would motivate one of ordinary skill in the art to selectively modify Martyn to incorporate specific features of McCarthy is “vague and conclusory,” at best. Therefore, the proposed combination of Martyn and McCarthy is improper.

For at least these reasons, the rejection of claims **26, 42, and 48** (and the claims depending therefrom) should be withdrawn.

D. General Comments on Dependent Claims

Each dependent claim is patentable for at least the same reasons as the independent claim on which it depends. Thus, Applicants believe that it is unnecessary at this time to argue the allowability of each dependent claim individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

E. Authorization for Email Communication

Recognizing that Internet communications are not secure, Applicants hereby authorize the USPTO to communicate with any authorized representative concerning any subject matter of this application by electronic mail. Applicants understand that a copy of these communications will be made of record in the application file.

F. Conclusion

In general, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as a concession of any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney can be reached at the address shown below. All communications should be directed to the undersigned at her direct line (857) 413-2056 or e-mail address: rma@cantor.com.

Respectfully submitted,

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